

REMARKS/ARGUMENTS

Claims 1-5, 7-16, and 18-21 have been previously presented and remain pending in the application. Claim 18 has been amended. No new matter has been added. Examiner rejects claims 1-5, 7-16, and 18-21 under 35 U.S.C. §103 as being obvious. Applicants respectfully submit that claims 1-5, 7-16, and 18-21 are not obvious over the cited references.

RESPONSE TO § 103 REJECTIONS

In the Office Action mailed April 20, 2006, the Examiner rejected claims 1-5, 7-16 and 18-21 under 35 U.S.C. § 103 as being unpatentable over Abbott et al. (U.S. Patent 6,671, 808) (hereinafter, "Abbott"), and further in view of Burger (U.S. Pub. 2005/0060586) (hereinafter, "Burger").

NO SUGGESTION OR MOTIVATION TO COMBINE

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. 2143.01

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the Office Action mailed April 20, 2006, the Examiner states that it would have been obvious to one ordinary skill in the art at the time of invention to combine the teachings of Abbott and Burger. In particular, the Examiner cited lines 9 to 15 of column 7 of Abbott. However, after a careful review of this passage, Applicants submit that there is no teaching, suggestion nor motivation to combine with Burger in this passage.¹ In fact, because the security of the personal key itself is not important, there is no need for authentication of the personal key itself. As the passage indicates, Abbott is only interested in the security of the stored information in the personal key. Thus, Abbott teaches away from combining with Burger.

Furthermore, Abbott is directed to "computer peripherals, and in particular to a personal key providing integrated password and digital certificate management, software security, and personal identification capability in a single compact package." In contrast, Burger is directed to a device for "producing, distributing, storing, and using the typical contents of a person's wallet, as well as the multiple, separate transaction authorization devices." There is no suggestion nor any mention in either reference to combine.

The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP

¹ "While the portability and utility of the personal key has many advantages, it also has one important disadvantage. It can be lost or stolen. This is especially troublesome because the personal key 200 (but not necessarily the personal key 200 itself) is highly important."

2143.01).

Thus, independent claims 1 and 11 are not obvious over Abbott in view of Burger. For the same reasons, claims 2-5, 7-10, 12-16, and 18-21 which depend from independent claims are also not obvious.

CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jong P. Hong at (650) 328-8500.

If there are any additional charges, please charge Deposit Account No. 50-2638 for any fee deficiency that may be due.

Respectfully submitted,



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Date: June 20, 2006

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